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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,318	06/19/2000	Frank Venegas JR.	IDS-10505/14	4057

25006 7590 07/16/2007  
GIFFORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C  
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EXAMINER
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YIP, WINNIE S

ART UNIT	PAPER NUMBER
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3636

MAIL DATE	DELIVERY MODE
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07/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/597,318	<b>Applicant(s)</b> VENEGAS, FRANK	
	<b>Examiner</b> Winnie Yip	<b>Art Unit</b> 3636	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Part II DETAILED ACTION***

In view of the Appeal Brief filed on March 15, 2007, PROSECUTION IS HEREBY REOPENED. New ground of rejection has been set forth below.


To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

**Dunn, David.**

  
DAVID DUNN  
SUPERVISORY PATENT EXAMINER

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The amendment filed on August 3, 2007 has been entered.

Claims 8-12 are pending in the application. Claims 1-7 and 13-15 have been cancelled.

### ***Double Patenting***

1. Claim 8 stand provisionally rejected under the judicially created doctrine of double patenting over claims 35 and 38 of copending Application No. 10/827,975. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully encompassed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a cover comprising/consisting an elongated, generally cylindrical plastic sleeve having consistent wall, a hemispherical/dome shaped upper end and an open lower end, and the inner wall/interior diameter in a range of 3 to 8 inches as claimed accept different wordings. Specifically, claim 8 recites "the hemispherically shaped upper end" is a species of the generic category defined by "a dome-shaped closed end" of claim 35 of the co-pending application. In the other words, claim 35 and 38 of the co-pending application fully encompasses the subject matter of claim 8 of the application, and therefore anticipates claim 8.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending

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application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejection - 35 USC § 103***

2. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arth, Jr. (US patent No. 5,299,883) in view of Kervin (US Patent No. 2,450,345).

Arth, Jr. shows and discloses a cover for covering a post (16) extending upwardly from the ground surface, the cover consisting of : an elongated, generally cylindrical plastic sleeve (18) having an opened first end and a closed, hemispherically shaped upper end (20), the plastic may be polyethylene. the sleeve (18) having an interior cavity with an interior diameter, and the sleeve having a substantially consistent wall thickness except an inner extending lip formed adjacent the opened first end. However, Kervin teaches a cover for covering a post (52), the cover consisting of : an elongated, uniform and smooth cylindrical plastic sleeve (15) having an open lower end terminating in a non-flared circular edge and a closed upper end (16), the sleeve (15) having an interior diameter and a consistent wall thickness including the closed upper end, a inner extending lip attached to the interior cavity of the sleeve for providing locking lip to prevent movement of the cover over the post. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the cover of Arth, Jr. having the sleeve formed with a consistent wall thickness from the closed end to the opened end as claimed and having the inner extending lip being formed separately to attach to the cover as taught by Kervin for engaging the post and preventing the movement of the cover from the post, since it has been held to be within the general skill of a worker in the art to form a unitary piece by integral of

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parts as a matter of obvious engineering choice. In *re* Larson, 144 USPQ 347 (CCPA 1965); In *re* Lockart, 90 USPQ 214 (CCPA 1951).

Further, although Arth, Jr. does not explicitly define the sleeve having the interior diameter about 3 to 8 inches as claimed invention, Arth, Jr. discloses the cover being used for covering the variety different dimension posts (see col. 2, line 43) which are generally for guarding of vehicle traffic which generally at least above 4 inches. Since both covers of Arth, Jr. and the claimed invention are used in the same field, it would have been obvious to one ordinary skill in the art at the time the invention was made to vary the dimensions of the interior diameter of the sleeve of the cover of Arth, Jr. as claimed because to do so would merely involve a matter of obvious design choice for the purpose of providing a cover to accommodate various different dimensional posts to be covered, and it appears that the claimed invention would perform equally well with the sleeve being formed with a pre-selected diameter in the range of 3 to 8 inches as claimed to achieve the desirable result of covering variety of different dimensioned posts. And, a change in size is generally recognized as being within the level of ordinary skill in the art. *In re* Rose, 105 USPQ 237 (CCPA 1955).

Regard to claims 9-11, Arth Jr. teaches the cover is made of various polymeric plastic such as polyethylene, polypropylene, ABS or PVC (see col. 3, lines 15-32) with the plastic generally includes an agent to provide a suitable durable coloring throughout. Although Arth Jr. or Kelvin do not define the cover being made of polycarbonate as claimed, it would have been obvious to one skilled in the art at the time the invention was made to modify the cover of Arth Jr. combined with Kelvin being made of polymeric plastic such as specifically of polycarbonate as claimed as a functional equivalent material to take the advantage of polymeric plastic

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properties such as adequate mechanical, sufficient impact strength characteristics, and wear properties. All of the foregoing is within the skills, competence and knowledge of the person with ordinary skills in the covering art.

3. Claim 8 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Beatty (US Patent No. 4,516,756) in view of Arth, Jr. '883.

Beatty shows and discloses a cover for covering a post (12 or 20), the cover consisting of an elongated, uniform and smooth cylindrical plastic sleeve (10 or 18) having an open lower end, and a closed upper end with variety of shapes, the sleeve (18) having an interior diameter and a consistent wall thickness including the closed upper end. Beatty further teaches the plastic sleeve being made of molded plastic having a durable coloring pigment throughout for providing a cover having color without coating or painting. Although Beatty does not explicitly define the sleeve having the interior diameter about 3 to 8 inches as claimed invention, Beatty had disclosed the cover being used for covering the variety different dimension posts for fence (see col. 1, line 48) which generally has a 4x4 cross section with a width of 4 inches. Since both covers of Beatty and the claimed invention are used in the same field, it would have been obvious to one ordinary skill in the art at the time the invention was made to vary the dimensions of the interior diameter of the sleeve of the cover of Beatty about 3 to 8 inches as claimed because to do so would merely involve a matter of obvious design choice for the purpose of providing a cover to accommodate various different dimensional posts to be covered, and it appears that the claimed invention would perform equally well with the sleeve formed with a preselected diameter in the range of 3 to 8 inches as claimed to achieve the desirable result of

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covering variety of different dimensioned posts. And, a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

And, although Beatty does not specifically define the closed upper end of the sleeve of the cover specifically having a hemispherical shape as claimed, however, Beatty discloses the cover (10, 18) may have variety inner dimensions and variety shapes of upper end, and the cover is used to cover "roughly hewn post" that may with roughly shaped upper end to provide a smooth surface and present a pleasing appearance. And, Arth, Jr. teaches a cover for covering a post, the cover consisting of an elongated sleeve having a closed and hemispherical shaped upper end for providing a deformable and cushionable protection over the post and providing a choice of pleasing appearance. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the cover of Beatty having the closed upper end of the sleeve specifically formed with a hemispherical shaped as taught by Arth, Jr. for covering a post with a printed and smooth surface and providing a desired pleasing appearance since the applicant has not disclosed that the specific shape of the closed upper end and the specific diameter of interior of a cover solve any stated problem or is for any particular purpose and it appears that the claimed invention would perform equal well with the upper end of the sleeve being formed with a hemispherical shape instead of a flat or pointed end to cover the post with a preselected appearance. And, a change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

4. Claim 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voegeli (US patent No. 3,812,279).



Voegeli shows and discloses a cover (12) capably used for a substantially rigid elongated cylindrical stanchion (21) having a lower end associated with the ground, the cover (12) consisting of: an elongated, generally cylindrical sleeve (12) being made of a plastic such as polyethylene (see col. 2. line 66), the cylindrical sleeve (12) having an open lower end (25) and a closed, hemispherical shaped dome upper end, the cylindrical sleeve (12) having a consistent wall thickness including the enclosed hemispherically shaped upper end, the sleeve (12) having a generally cylindrical interior cavity having an interior diameter. Although Voegeli does not explicitly define the interior diameter of the cylindrical interior cavity of the sleeve being in the range of 3 to 8 inches, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify the cover of Voegeli to vary the dimensions of the interior diameter of the sleeve of the cover as claimed because to do so would merely involve a matter of obvious design choice for the purpose of providing a cover to accommodate various dimensional stanchion to be covered since the applicant has not disclosed that the specific shape of the closed upper end and the specific diameter of interior of a cover solve any stated problem or is for any particular purpose and it appears that the claimed invention would perform equally well with the sleeve being formed with an interior diameter having a pre-selected dimension in the range of 3 to 8 inches as claimed to achieve the desirable result of covering variety of different dimensioned posts. And, a change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regard to claims 10-11, although Voegeli does not specifically define what specific type of plastic material that the cover is made as claimed, Voegeli does teach the cover teaches a cover consisting of an elongated sleeve being made of plastic such as polyethylene (see col. 2,

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line 66), wherein the plastic such as polyethylene inherently made with an agent to provide choice of colors. It would have been obvious to one skilled in the art at the time the invention was made to modify the cover of Voegeli being made of plastic such as polycarbonate for forming a cover having advantage of the polymeric plastic's desirable properties such as having sufficient impact strength characterizes, corrosion and wear properties such as thermal expansion, moisture absorption and resistance to chemical attack to allow it being used outdoor. All of the foregoing is within the skills, competence and knowledge of the person with ordinary skills in the covering art.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arth, Jr. '883 in view of Kervin '345, or over Voegeli '279, or over Beatty in view of Arth, Jr. '883 as applied to claim 8 above, and further in view of Finger et al. '328.

Arth, Jr., Kervin, Beatty, and Voegeli teach all structural limitations as claimed as explained and applied above rejections except that Arth, Jr. or Kervin or Beatty or Voegeli does not specifically define what specific type of plastic material including an additive to resist ultraviolet deterioration. Finger et al. teach a cover for a covering a post, the cover consisting of an elongated sleeve (27) being made of plastic such as polyethylene and including an additive with an ozone resistant material and a treatment for protection against ultra violet deterioration. (see col. 5, lines 15-17). It would have been obvious to one skilled in the art at the time the invention was made to modify the cover of Arth, Jr. as combined with Kervin or the cover of Voegeli or the cover of Beatty as combined by Arth, Jr. being made of polymeric plastic having

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an additive as to resist the ultraviolet deterioration as taught by Finger et al. for protecting the cover in action of outside under rain and sunlight.

***Response to Argument***

6. Applicant's arguments filed on March 15, 2007 have been fully considered and new grounds of rejections are set forth above.

In response to applicant's argument that Finger et al. '328 is not anticipated of the claimed invention, it is deemed persuasive. The rejection under 35 U.S.C. 102 (b) as being anticipated by Finger et al. is withdrawn.

In response to applicant's argument that there is no suggestion to combine the references Beatty in view of Arth, Jr., the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). We agree that Beatty does not show the covers and post having a top end with a hemispherical shape, otherwise the rejection will be under 35 USC 102 status. Applicant's argument that Beatty does not disclosed a wooden post would need to be rounded off to have the cover including a hemispherical upper end is not persuasive because applicant only claims a cover but not with the post. In fact, Beatty does not limit the cover only for covering a post having a point end or flat end as shown. Beatty discloses the cover having an

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enclosed upper end may be formed with suitable shapes for covering the post which is unpainted, roughly hewn wood picket (or wooden post), wherein the post may have a rough upper end with different shape such as flatted (12) or pointed (12), or may be a roughly hemispherical shape as claimed. As applicant described in the specification, the cover may be formed with alternative embodiment with the top end can be formed in variety of shapes as shown in Figs. 6-9, 10A and 10B. In this case, both references to Beatty and Arth, Jr. teach a cover used for covering a post being used for road guarding to improve the post with a smooth pleasing appearance and to protect the post from weathering and rotting from effects of rain, sunshine, and wind. And, Arth, Jr. is used as a teaching reference to only to teach the cover would have been modified with other shaped top end such as a hemispherical top as claimed. Therefore, one of ordinary skill in the art, would have expected applicant's invention to perform equally well with the either an enclosed flatten top end of Beatty or hemispherical shaped dome top as taught by Arth, Jr. as an obvious matter of design choice to accommodate the shape of the stanchion to be used for covering a rough surface of a post to protect a penetration of the stanchion through the sleeve and having desirable aesthetic appearance. Accordingly, prima facie obviousness is established.

Therefore, the rejection still granted.

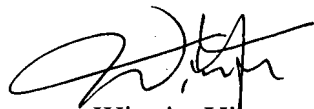
### ***Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 571-272-6870. The examiner can normally be reached on M-F (9:30-5:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Dunn can be reached on 571-272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Winnie Yip  
Primary Examiner  
Art Unit 3636

wsy  
July 5, 2007